UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/621,988	12/04/90	OPPERMANN H	CRP-001CP2DV

DC

EXAMINER
NUTTER, N

EDMUND R. PITCHER, ESQ.
TESTA, HURWITZ, & THIBEAULT
53 STATE STREET
BOSTON, MA 02109

ART UNIT	PAPER NUMBER
1503	11

DATE MAILED: 10/31/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 30 Sept 91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 21-26, 28, 29, 32-46, 50, 51 and 81-95 are pending in the application.
   Of the above, claims 22, 32, 33, 36-44 and 87-95 are withdrawn from consideration.
2. ☒ Claims 1-20, 27, 30, 31, 47-49, 52-80 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 21, 23-26, 28, 29, 34, 35, 45, 46, 50, 51 and 81-86 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____; has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

VAC

EXAMINER'S ACTION

PTOL-326 (Rev.9-89)

Applicant's election of the species of claim 34 in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

Claims 21-26, 28, 29, 32-46, 50, 51, and 81-95 are presently in the application.

Claims 21, 23-26, 28, 29, 34, 35, 45, 46, 50, 51, and 81-86 are deemed to read on the elected species.

Claims 22, 32, 33, 36-44 and 87-95 are withdrawn from consideration as being drawn to non-elected species.

Claims 34 cannot properly depend from claim 22 since the sequence recited therein differs significantly. Likewise for other claims reading on the elected species.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112,

190

first paragraph, as failing to provide an adequate written description of the invention.

The specification as filed does not disclose at pages 9-10, 62 or 63 what specifically may be embraced by each representation of "X" as amino acids. While preferred amino acids are disclosed, conceivably many others may be embraced thereby.

Claims 21, 23-26, 28, 29, 45, 46, 50, 51, 81 and 82 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 21, 23-26, 28, 29, 34, 35, 45, 46, 50, 51 and 81-86 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since the specification does not teach precisely what "X" may represent, the proper metes and bounds as to what may be embraced by claims 21, 23-26, 28, 29, 45, 46, 50, 51, 81 and 82 cannot be clearly ascertained. Further, while claims 81 and 82 recite distinctive amino acids for the "X" moieties, the myriad of possibilities for these amino acids become infinitesimal in scope.

Claim 46 refers to Figure 1A in its recitation. While not formalized into a rule, there is a long-standing policy and practice in the Office that a claim should be self-contained to

the extent possible to fulfill the statutory requirement of particularly pointing out and distinctly claiming what applicant regards as his invention. This practive facilitates examination of the claimed invention by having the subject matter all in one place, avoids complicating the examination process by adding the processing of drawing and possible correction thereof to the Office procedures, and permits the claimed subject matter to be easily modified without possible correction of drawings and potential modification of the scope of the disclosure as originally filed. The long standing practive also serves the publuc by placing the claimed subject matter in one location without having to refer back and forth to at least two different places.

Claims 83 and 84 are substantive duplicates of claims 34 and 35, respectively.

35 U.S.C. § 101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 21,23-26, 28, 29, 34, 35, 45, 46, 50, 51, and 81-86 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-19 and 21 of copending application Serial No. 660, 162. This is a *provisional* double patenting rejection since the conflicting claims have not in fact

been patented.

Claims 21, 23-26, 28, 29, 34, 35, 45, 46, 50, 51, and 81-86 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 58-61 of copending application Serial No. 232, 630. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Claims 21, 23-26, 28, 29, 34, 35, 45, 46, 50, 51 and 81-86 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 23 of copending application Serial No. 569,920. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

N.Nutter:tj
October 30, 1991

NATHAN M. NUTTER
PATENT EXAMINER
ART UNIT 153

1990